

REMARKS

Claims 1-12 were pending in this application. Claim 1 has been amended by incorporating the limitations of claim 8 therein. Accordingly, claim 8 has been cancelled. No new claims have been added. No new subject matter has been added by this amendment. Therefore, claims 1-7 and 9-12 remain in this application.

35 U.S.C. §103 Rejections

Claims 1-12 stand rejected under 35 U.S.C. §103(a) for obviousness based upon the Safe-Fence reference in view of the Johnson patent. The Examiner maintains that although the Johnson patent may not be analogous art, it is nonetheless reasonably pertinent to the particular problem with which the inventor was concerned, and therefore it may still be relied upon as a basis for rejection (*In re Oetiker*, 997 F.2d 1443 (Fed. Cir. 1992)). The Examiner asserts that the teachings of the Johnson patent (i.e., constraining function) are pertinent to solving the problem of constraining the fence rail in the slotted connector. Therefore, the Examiner continues to assert that the Johnson patent may still be relied upon in his rejection.

However, Applicant wishes to point out that the Examiner has not further inquired into the interpretation of the “reasonably pertinent” aspect of the test offered in *Oetiker*. According to the relevant case law, a “reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem” (*Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993)). The Johnson patent is clearly “in a different field from that of the inventor’s endeavor.” An inventor attempting to secure a fence rail would not have looked at the art of wrapping a box or other package via strapping, but rather to the field of fencing. As support for this assertion, for example, the Johnson buckle is a single buckle used to connect two opposite ends of a strap to opposing ends of the buckle to encircle the box. This is in contrast to how the current invention works – a slotted connector for securing a rail to a post. Another slotted connection is then required to connect

the free end of the rail to another post. In view of the aforementioned case law and the application of law in those cases, Applicant believes that the Examiner is clearly wrong as a matter of law in his reliance on the Johnson patent to reject the pending claims. The Examiner's reference to the Johnson patent appears to arise from impermissible hindsight.

The Johnson buckle is used to connect two opposing ends of a non-rigid strap *around* a package. Therefore, the Johnson patent deals with (a) wrapping packages (not fencing); and (b) a buckle for securing a non-rigid strap, as opposed to a rigid fence rail. Furthermore, the present invention does not require friction engaging roughened surfaces as in the Johnson invention. It is Applicant's view that the Examiner is using hindsight to pick and choose a piece of the Johnson patent out of context from the other features that the Johnson patent discloses.

To further define the invention, Applicant has amended independent claim 1 to incorporate the limitation of claim 8 requiring that the rail be rigid, yet manually deformable. The Examiner has indicated that this limitation is met by Safe-Fence in the instance "when the rail is assembled with the connector and is pulled taut." The interwoven polymeric webbing polytape in Safe-Fence cannot in and of itself be construed as being rigid, let alone manually deformable. The Installation printout of Safe-Fence previously provided by the Examiner specifically states that one should be careful to "not over-stretch [the] polytape." This indicates that the tape is not a rigid material. Furthermore, one needs to "hand-tighten [the poly-tape] to eliminate sagging between fence posts." This indicates that the poly-tape cannot be manually deformed while still retaining its rigidity. The Examiner is construing the aforementioned limitation in the context of an installed tape. The installed tape is simply not "rigid, yet manually deformable" given the plain meaning of such wording.

The Federal Circuit reviewed an application in which the claim related to an athletic shoe with cleats that "break away at a preselected level of force" and thus prevent injury to the wearer. The examiner rejected the claims over prior art teaching athletic shoes with cleats not intended to break off and rationalized that the cleats would break away given a high enough force. The court reversed the rejection stating that when interpreting a claim term which is ambiguous, such as "a preselected level of force", we must look to the

specification for the meaning ascribed to that term by the inventor. The specification had defined “preselected level of force” as that level of force at which the breaking away will prevent injury to the wearer during athletic exertion (*In re Weiss*, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993)).

Accordingly, we must look to the specification of the present application. Paragraph [0019] describes the rail as having a construction that is “conducive to manual deformation of the rail, yet retaining a high degree of stiffness in the rail. It is to be understood that any other type of rail fencing exhibiting stiffness and deformability qualities inherent in composite metal and plastic web fencing may also be utilized. For example, in the preferred embodiment, the rail is rigid enough that, when a section of it is placed on an edge of a tabletop, it is self-supporting.” The aforementioned description of the rail, whether in the preferred embodiment or otherwise, all refer to the rail itself being inherently rigid. Therefore, the “rigid, yet manually deformable” limitation cannot be equated to the Safe-Fence tape being in an assembled and pulled-taut state.

Since the Johnson patent is non-analogous art and the Examiner’s attempt to meet the “rigid, yet manually deformable” limitation is legally improper, Applicant believes that the subject matter of the pending claims is not rendered obvious by the Safe-Fence reference in view of the Johnson patent.

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CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-7 and 9-12 are respectfully requested.

Respectfully submitted,

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